IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: S.C. Cottrille et al.   Attorney Docket No.: MSFT117226

Application No.: 09/339,634   Group Art Unit: 2176

Filed: June 24, 1999   Examiner: A. Yuan

Title: ASSOCIATING ANNOTATION WITH A CONTENT SOURCE

REQUEST FOR RECONSIDERATION TRANSMITTAL LETTER/ PETITION FOR EXTENSION OF TIME

Seattle, Washington 98101

April 9, 2004

TO THE COMMISSIONER FOR PATENTS:

A.   Request for Reconsideration Transmittal

Transmitted herewith is a Request for Reconsideration in the above-identified application.

___X___   1. No additional claim fee is required, as shown below.

COMPUTATION OF FEE FOR CLAIMS AS AMENDED

	Claims Remaining After Response		Highest Number Previously Paid For		Present Extra		Rate		Additional Fee
Total Claims	19	-	20	=	0	x	18	=	0
Independent Claims	3	-	3	=	0	x	86	=	0
	TOTAL								$0

B.   Petition for Extension of Time

Applicants respectfully request that the shortened statutory period for response to the outstanding Office Action dated December 18, 2003, set to expire on March 18, 2004, be extended by one (1) month, to expire on April 18, 2004. The enclosed check includes the one-month extension fee of $110.00.

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C.   Fees Enclosed

Enclosed is our Check No. 154898 in the amount of $110.00 to cover the request for extension of time fee.

D.   Additional Fee Charges or Credit for Overpayment

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.18 which may be required during the entire pendency of the application, or credit any overpayment, to Deposit Account No. 03-1740. This authorization also hereby includes a request for any extensions of time of the appropriate length required upon the filing of any reply during the entire prosecution of this application. A copy of this document is enclosed.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS PLLC

Timothy R. Wyckoff
Registered Patent Agent
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Direct Dial No. 206.695.1641

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: _April 9, 2004_   _Sheila B. King_

TRW:sbk

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REQUEST FOR RECONSIDERATION

Seattle, Washington 98101 **RECEIVED**

April 9, 2004   APR 2 0 2004

Technology Center 2100

TO THE COMMISSIONER FOR PATENTS:

The non-final Office Action dated December 18, 2003 ("Office Action"), rejected all of the pending claims of the instant application. Independent Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over van Hoff, U.S. Patent No. 5,822,539, in view of publication "Scope of Annotation Protocol" ("Annotation Protocol"). In addition, Claims 1-6 and 18-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over van Hoff in view of Van Der Meer, U.S. Patent No. 6,289,362 B1, and further in view of the publication Annotation Protocol. This Request for Reconsideration sets forth arguments as to why applicants believe that the Examiner's position with respect to the pending claims is incorrect and should be withdrawn.

Although previously provided in a Response associated with the instant application, the applicants once again provide below a summary of the invention, which relates to various exemplary embodiments of the invention. It is to be understood that the following summary of applicants' invention is not provided to define the scope or interpretation of any of the claims of this application. Instead, this discussion is provided to help the United States Patent and Trademark Office better appreciate important claim distinctions discussed hereafter.

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Summary of the Invention

Generally, an exemplary embodiment of the present invention relates to annotations. As is commonly known, an annotation is defined as any object that is associated with another object by some relationship. The annotation object may be of any type and the relationship between the annotation object and the object that it annotates may also be of any type. An exemplary embodiment of the present invention provides a superior manner by which annotations may be stored and accounted for.

According to one exemplary embodiment of the present invention, a tier I server is employed to store one or more annotations associated with a document identifier. The tier I server handles a large number of requests from clients, and responds to requests as fast as possible. The tier I server is also specifically designed to determine if annotations are associated with a document and, if so, retrieve an index of annotations associated with the document from a tier II server.

In one exemplary embodiment, the tier II server contains indices for the contents of all annotations. The tier II server may also store annotation properties. Generally, the information stored on the tier II server is considered additional information to the annotation information stored on the tier I server.

Once the index of the annotation is retrieved from the tier II server, a reference to a tier III server may be made. The tier III server is the storage device that actually stores the annotation objects -- documents, for example. The end result is that an identified annotation object may be retrieved by a client based on initial referencing of the tier I and tier II servers.

The above described exemplary embodiment of the present invention provides a plurality of servers that function to provide quick reference to annotations. Speed of reference is achieved as a result of each upper tier of the tiered system having information in addition to the

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information in a tier below it. This, for example, allows a tier I server to store less annotation information than a tier II server.

Claim Rejections Under 35 U.S.C. § 103(a)

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over van Hoff in view of the publication Annotation Protocol. In addition, Claims 1-6 and 8-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over van Hoff in view of Van Der Meer, and further in view of the publication Annotation Protocol. For the reasons discussed below, Applicants respectfully submit that these documents, whether taken standing alone or in combination together, fail to teach or suggest the recitation of independent Claims 1, 7, and 16. Moreover, applicants respectfully submit that these documents are similarly deficient with respect to the dependent claims of the instant application. Moreover, applicants respectfully submit that the dependent claims are allowable at least due to their dependence upon an allowable claim.

Rejection of Claim 7

Independent Claim 7 sets forth a combination of limitations including "receiving reference from said tier I server to said tier II server, said tier II server maintaining additional information regarding the annotation associated with the document identifier." (Emphasis added.) For the following reasons, the documents relied upon in the Office Action, whether taken alone or in combination together, fail to teach or suggest at least this indicated limitation of independent Claim 7.

van Hoff teaches a web client computer 102 and a web information server 104. Interposed between the web client computer 102 and the web information server 104 is an annotation proxy server 118. (See Col. 4, lines 60-62.) The annotation proxy server 118 includes one or more annotation directories 191 and 192. Each annotation directory is uniquely

identifiable, such as by name or number, so that a user associated with the client computer 102 may select the desired annotation directory from among several that may be present on the proxy server 118. (See Col. 5, lines 28-32.)

When the client computer 102 requests a document, a user associated with the client computer 102 also specifies the annotation proxy server 118, and one of the annotation directories 191 and 192 provided on that server. (See Col. 5, lines 58-61.) Using annotation information stored in one of the directories 191 and 192, the proxy server 118 transmits a request to the server 104 for a document using a unique document identifier associated with an annotation stored in one of the directories 191 and 192. (See Col. 6, lines 41-43.)

As is clear from the above discussion, nothing in Van Hoff teaches receiving from a tier I server "a reference to said tier II server, said tier II server maintaining <u>additional information</u> regarding the annotation associated with the document identifier." (Emphasis added.) Instead, van Hoff teaches that all annotation information is specifically stored on the annotation proxy server 118.

The rejection of independent Claim 7 asserts, on page 3 of the current Office Action, that van Hoff teaches "receiving a reference from said tier I server to said tier II server, said tier II server maintaining additional information regarding the annotation associated with the document identifier." However, from a reading of van Hoff, as summarized above, it is clear that the so-called tier II server, which the Office Action associates with the web information server 104, does not contain annotation information. Instead, the web information server 104 only includes documents associated with annotations stored on the annotation proxy server 118. As a result, applicants submit that the Office Action's position regarding what is taught by van Hoff is incorrect.

The current Office Action recognizes, on page 4, that van Hoff does not disclose a "tier I server storing minimal information regarding annotations associated with said content source,

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said minimal information including the existence of annotations associated with said content source and the identification of said tier II server if said annotation exist[s]." The Office Action relies on the publication Annotation Protocol to make up for the deficiencies in the van Hoff disclosure. Applicants disagree. As discussed below, the disclosure of the publication Annotation Protocol does not make up for the deficiencies of van Hoff.

The publication Annotation Protocol teaches an annotation server that may store annotations for several distinct sets of URLs. The publication teaches that an annotation set may contain several annotation subsets that may be contained by several annotation supersets. Subsets and supersets may be on different servers. The publication further indicates that everything about a single set should probably be on a single server. (See p. 2, first paragraph of the publication.) The publication Annotation Protocol further teaches that annotation servers should be able to offer information to clients about all the URLs that have annotations or may have annotations so that clients may avoid making requests of a server that has no annotations in the set. This may be given in terms of a pattern of lists of alternate patterns to abbreviate the transfer and speed the look-up. The relied upon publication indicates that this should facilitate scaleable look-up of annotations by clients and servers.

It seems that the Examiner has misunderstood the context of the publication associated with the scaleable functionality indicated therein. As just a reminder, in order to make up for the deficiencies associated with the van Hoff patent document, discussed above, the publication must teach a "tier II server maintaining additional information regarding the annotation associated with the document identifier." (Emphasis added.) Such a tier II server, with additional information, is simply not taught by the publication Annotation Protocol.

The subsets and supersets referred to in the publication do not refer to the practice of storing annotation information on a first server, and additional annotation information that is stored on a second server, where the annotation information stored on the second server has

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associations with annotation information stored on a first server. Instead, the subsets and supersets merely refer to the practice of assigning a certain level of security or another related property, a set has associated other sets that inherit properties and/or security properties from the first set. This does not relate to the practice of having annotation information on a tier I server and further information associated with the annotation information stored on the tier I server, which is stored on a tier II server.

The scaleable functionality discussed in the publication Annotation Protocol relates to the use of annotation servers that are capable of identifying URLs that may or may not have associated annotations. The scalability functionality does not refer to a system or practice where a tier I server includes annotation information and a tier II server that includes further annotation information related to the annotation information stored on the tier I server.

In summary, applicants submit that the two documents relied upon in combination together to reject independent Claim 7, taken alone or in combination, fail to teach or suggest at least the indicated limitation of independent Claim 7. Accordingly, applicants respectfully request that the rejection of Claim 7 be reconsidered and withdrawn. With regard to the claims dependent upon Claim 7, applicants respectfully submit that these claims are allowable at least due to their dependence on an allowable independent claim.

Rejection of Claims 1-6 and 8-19

Independent Claim 1 sets forth a combination of limitations including "the information about the annotation but not the annotation is stored on a lower tier server and the annotation is stored on a higher tier server." (Emphasis added.) Independent Claim 16 sets forth substantially identical subject matter. Therefore, the following discussion as to why independent Claim 1 is patentable over the relied upon documents is also applicable to independent Claim 16.

The rejection of both independent Claims 1 and 16 includes a combination of van Hoff, Van Der Meer, and the publication Annotation Protocol.

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The Office Action asserts that van Hoff teaches "storing the annotation on the servers of a multiple tier hierarchical annotation server system wherein the information about the annotation but not the annotation is stored on a lower tier server and the annotation is stored on a higher tier server." (See p. 5 of the Office Action.) The teachings of van Hoff are described in detail above. Applicants reiterate that van Hoff simply does not teach a system that includes a server that has an annotation reference, and a subsequent server that includes further information that is related to annotation information on the first server.

As was previously discussed, the annotation proxy server 118 includes annotation directories 191 and 192. The Web server 104, in contrast, includes data, such as documents, that may be forwarded to the annotation proxy server 118 for annotating. van Hoff explicitly states that the annotation proxy server 118 "performs document parsing and annotation." (See Col. 4, lines 39-41.) van Hoff is accordingly limited to a system that includes annotations on one server and data, more specifically documents, on another server.

The patent to Van Der Meer was relied on in the Office Action to teach "an object including annotation," and the publication Annotation Protocol was relied upon to teach "storing the annotation and information about the annotation accessible using the document identifier." (See p. 6 of the current Office Action.) Even assuming *arguendo* that the Van Der Meer patent document and the publication Annotation Protocol teach that which they are asserted to teach, these teachings do not make up for the deficiencies of van Hoff. Accordingly, whether taken in combination or alone, the documents relied on in the Office Action to reject independent Claims 1 and 16 fail to teach or suggest the indicated limitations of the rejected independent claims. With respect to the rejected dependent claims, applicants respectfully submit that these claims are at least allowable because they depend upon an allowable independent claim.

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In accordance with the above, applicants respectfully request reconsideration and withdrawal of the rejection of independent Claims 1 and 16, and those claims that are respectively dependent thereon.

In view of the above comments, reconsideration and withdrawal of each of the outstanding claim rejections is respectfully requested.

CONCLUSION

In view of the foregoing amendments and remarks, applicants respectfully submit that the present application is now in condition for allowance. Reconsideration and reexamination of this application, as amended, allowance of the rejected claims, and passage of the application to issue at an early date are respectfully solicited. If the Examiner has any questions or comments concerning this application, the Examiner is invited to contact the undersigned at the number below.

Respectfully submitted,

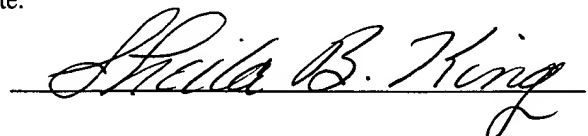CHRISTENSEN O'CONNOR
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I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: _April 9, 2004_

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